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IN THE
Supreme Court of the United States
OCTOBER TERM, 1995

HERBERT MARKMAN AND POSITEK, INC.,
Petitioners,

v.

WESTVIEW INSTRUMENTS, INC. AND
ALTHON ENTERPRISES, INC.,
Respondents.

**On Petition for a Writ of Certiorari
to the United States Court of Appeals
for the Federal Circuit**

BRIEF OF RESPONDENTS

FRANK H. GRIFFIN, III
Counsel of Record

PETER A. VOGT
POLLY M. SHAFFER
GOLLATZ, GRIFFIN & EWING, P.C.
Two Penn Center Plaza
Sixteenth Floor
Philadelphia, PA 19102
(215) 563-9400

*Attorneys for Respondents
Westview Instruments, Inc. and
Althon Enterprises, Inc.*

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QUESTION PRESENTED

In a patent infringement case tried to a jury, does the court have the power and obligation to construe as a matter of law the meaning of language used in the patent claim when either (a) that meaning is discernable from the patent documents or (b) extrinsic evidence is necessary as an aid to construction?

LIST OF PARTIES PURSUANT TO RULES 24.1(b) AND 29.1

The names of all parties in the court whose judgment is sought to be reviewed appear in the caption of this Brief of Respondents.

Neither Respondent Westview Instruments, Inc. nor Respondent Althon Enterprises, Inc. has any parent companies or subsidiaries.

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**On Petition for a Writ of Certiorari
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BRIEF OF RESPONDENTS

**Constitutional and Statutory
Provisions Involved**

U.S. CONST. AMEND. VII provides:

In Suits at common law, where the value in controversy shall exceed twenty dollars, the right of trial by jury shall be preserved, and no fact tried by a jury, shall otherwise be re-examined in any Court of the United States, than according to the rules of the common law.

35 U.S.C. §112.

The full text of 35 U.S.C. §112 is reprinted in full in an appendix to the Brief of Respondent.

STATEMENT OF THE CASE

Nature of the Case

This is a patent infringement case that raised no issues of fact for the jury. The Petitioner's patent, described more fully below, claims a system that utilizes bar codes to track clothes or other articles in a dry cleaning establishment to allow the detection of lost, stolen or added *articles*. The Respondent's system prints bar-coded invoices, thereby allowing the detection of missing or extra *invoices*. At trial, the facts concerning the capabilities of the accused system were undisputed. The only question was whether the language of the claims could be read to cover the accused system. That language was not complex, scientific or technical. A typical issue was whether the word "inventory" meant "articles of clothing," or "cash," or "invoices." The only witness who attempted to interpret the claim language was Petitioners' expert — a patent lawyer with no skill in the dry cleaning art — whose legal conclusions were rejected by the court.

The trial court determined the meaning of the patent claims as a matter of law from the patent documents. Since no factual dispute remained, the trial court granted Respondents' Motion for Directed Verdict. The trial court's ruling was unremarkable and consistent with both standard federal practice and the requirements of the Seventh Amendment. The United States Court of Appeals for the Federal Circuit affirmed the trial court's judgment and reaffirmed the longstanding proposition that construction of patent claims is an issue of law for the court.

The heart of Petitioners' attack on the Federal Circuit's decision is their argument that the Seventh Amendment mandates that any resort to extrinsic evidence, such as expert testimony, turns claim interpretation from an issue of law to an issue of fact. The Federal Circuit ruled that neither logic nor precedent supported Petitioners' argument that the Seventh Amendment prohibits claim interpretation as a matter of law.

1. The Patent-in-Suit. The patent at issue is United States Reissue Patent No. 33, 054, which claims an inventory control

and reporting system, primarily for use in dry cleaning stores. The system enables the dry cleaner to identify, calculate and process costs of laundry articles to be cleaned, to print bar-coded records and tags for attachment to the laundry articles, to scan bar-coded tags on articles so as to monitor their location, and to generate reports based upon the information contained in the records and obtained by the scanner or scanners. J.A. 293-301. As summarized in the patent's specification, the dry cleaning process involves intermingling large numbers of clothes from different customers in one dry cleaning machine. J.A. 296, col. 1, ln. 42-45. Each article of clothing is labelled with an article tag bearing a unique, sequential number. J.A. 296, col. 2, ln. 5-9. The tags are used so that the customer's clothes can be reassembled in one batch after dry cleaning. J.A. 300, col. 9, ln. 41-46. The article tag numbers are also printed on the customer's invoice. J.A. 294, Fig. 2. Once the clothes are cleaned, individual articles are regrouped into the customer's original batch by matching the numbers on the article tags with the numbers on the invoice.

2. Prosecution History. The initial patent application was rejected for obviousness. J.A. 308-309. The original patent was issued only after amended claims were submitted to distinguish its claims over the prior art. J.A. 310-318. The amendments contain limiting language that defines the boundaries of the invention and distinguishes the patent from Respondent Westview's system. Amended claim 1 is reproduced below. Language deleted from the original claim 1 is in brackets and language added to the original claim 1 is italicized.

1. An inventory control and reporting system, comprising:

a data input device for manual operation by an attendant, the input device having switch means operable to encode information relating to sequential transactions, *each of the transactions having articles associated therewith, said information including transaction identity and descriptions of each of said [a plurality of] articles associated with the transactions [a transaction];*

a data processor including memory operable to record said information *and means to maintain an inventory total,*

said data processor having means to associate sequential transactions with unique *sequential* indicia and to generate at least one report of *said total and said transactions, the unique sequential indicia and the descriptions of articles in the sequential transactions being reconcilable against one another*; [and,]

a *dot matrix* printer operable under control of the data processor to generate a written record of the indicia associated with sequential transactions, the written record *including* [comprising a plurality of] optically-detectable bar codes having a series of contrasting spaced bands, the bar codes being printed *only* in coincidence with each said transaction and at least part of the written record bearing a portion to be *attached to* [directly associated with] said articles; *and*,

at least one optical scanner connected to the data processor and operable to detect said bar codes on all articles passing a predetermined station,

whereby said system can detect and localize spurious additions to inventory as well as spurious deletions therefrom.

J.A. 308-309.

After issuance of the original patent, Petitioner Markman applied for a reissue patent in which he sought to broaden the patent by adding two new claims. In the reissue application, Markman stated that the original patent was invalid because he had claimed less than he had a right to claim. J.A. 319-320. The patent examiner at first rejected the reissue application. J.A. 2292-93. Upon reconsideration, the patent examiner issued United States Reissue Patent No. 33,054, which retained all of the original claims and added two new claims, 14 and 15. J.A. 293-301. The two new claims broadened the original patent. For example, Claim 14 of the reissue patent did not require a dot matrix printer, did not require descriptions of each article to be encoded and did not require the data processor to be connected to the optical scanner.¹

1. As explained in Respondents' Brief in Opposition to the Petition for

3. The Purpose of the Invention Defined by the Patent.

The patent defines an invention intended to prevent the loss or theft of clothes or the processing of undocumented clothes. Markman's remarks to the patent examiner describe the problem that his patent was meant to solve:

As described in the specification, some basic difficulties with retail dry cleaning establishments relate to the fact that attendants sometimes process undocumented articles through the system and pocket the proceeds. Another difficulty is that the loss, misplacement or separation in process of even a single article of even relatively minor value will have a major impact on the customer's estimation of the quality of the establishment.

J.A. 314-315.

To curtail the processing of undocumented articles and the loss or theft of even a single item of clothing, Markman's system, as defined by the patent, tracks articles of clothing through the dry cleaning process. The tracking of articles is accomplished by printing bar-coded article tags, attaching the tags to articles of clothing and scanning them at predetermined stations.

The function and purpose of the patent is apparent on its face. The patent specification describes Markman's invention as relating to "inventory control devices capable of monitoring and reporting upon the status, location and throughput of inventory in the establishment." J.A. 296, col. 1, ln. 12-15. The last paragraph of claim 1 explains that "said system can detect and localize spurious additions to inventory as well as spurious deletions therefrom." J.A. 301, col. 11, ln. 9-11. The additions or deletions are discovered by the scanning of "bar codes on all articles passing a predetermined station." J.A. 301, col. 11, ln. 7-8. The specification summarizes the function of the invention, stating that "the progress of articles through the laundry

Certiorari, the Patent and Trademark Office issued a final rejection of the patent in this case on July 26, 1994, after the *in banc* hearing before the Federal Circuit. The rejection was the result of numerous challenges on the basis of prior art. A decision is pending from the Board of Patent Appeals and Interferences on the appeal of the final rejection.

and dry cleaning system can be completely monitored." J.A. 296, col. 2, ln. 55-56. The claims and specification make it clear that the patent claims a system which has the ability to track individual articles of clothing through the dry cleaning process, to detect and localize missing and additional articles of clothing and to generate reports about the status and location of the individual articles of clothing.²

4. The Accused System. The accused system was invented and manufactured by Respondent Westview Instruments, Inc. for use in the dry cleaning business.³ The facts about the accused system are not in dispute. The accused system consists of two units, the DATAMARK and the DATASCAN. J.A. 307. The DATAMARK prints bar coded invoices that contain information about the customer, the clothes to be cleaned and charges for cleaning. J.A. 307. The DATAMARK stores in memory only the invoice number and the invoice cash total. J.A. 303. The DATASCAN is a portable bar code reader containing a microprocessor used to read bar codes on invoices wherever they are located. J.A. 204. After the invoice list is transferred from the DATAMARK to the DATASCAN, the

2. The inventor's application for the reissue patent further emphasized that the claimed patent tracks articles:

The limitations which render the claims unnecessarily narrow over all known prior art, are:

1. Tracking of individual articles.

It may be argued that the claims are limited to a system that tracks individual articles such as individual pieces of clothing brought by a single customer to a drycleaning establishment or the like The claim language recites entry of "descriptions of each of said articles associated with the trans-actions." This passage is more limited than I had a right to claim because, although individual articles, e.g. a pair of pants, could be accounted for by marking, scanning and reconciliation in reports, the grouping of such articles into sets for tracking is reasonably disclosed as forming part of the invention and is allowable over the prior art.

J.A. 320-21.

While claim 14 was expanded to include the tracking of groups of articles rather than individual articles, the focus of the invention remained on the tracking of articles, not invoices.

3. Respondent Althon Enterprises is a drycleaner that purchased the accused system.

DATASCAN is carried through the store, reading bar codes on invoices wherever they are found. J.A. 204, 303. The DATASCAN will then report any discrepancy between the list of invoice numbers it has received from the DATAMARK and the numbers of the invoices that it has actually read. J.A. 303. In this way, the accused system detects extra or missing invoices. It cannot localize where those additions or deletions occurred because DATASCAN is portable and does not operate at a fixed, predetermined station. J.A. 204. While the accused system can compute the cash total, it has no ability to generate a report in which the article descriptions and the invoice numbers are reconcilable against one another. J.A. 303. The invoice itself is the only document the Westview system prints that contains article descriptions. J.A. 912.

The accused system does not track articles of clothing individually or in batches. To track such articles, the DATAMARK would also have to print bar-coded tags for attachment to them. It does not. J.A. 219. The only bar-coded document that the DATAMARK prints is the invoice. Similarly, the DATAMARK stores the invoice numbers in memory but does not retain descriptions of individual articles of clothing. J.A. 208-209. Since the DATAMARK does not tag individual articles or retain information about them, it cannot detect or locate deletions or additions of articles as they pass through the dry cleaning process. J.A. 204.

5. Procedural History. Before trial, Respondents moved for summary judgment on the question of infringement on the grounds there was no genuine factual dispute about the accused device and Respondent were entitled to judgment in their favor upon the proper legal interpretation of the claims. The trial court denied the motion. After Respondents moved for reconsideration, the court issued an order stating, "There is a genuine issue of material fact as to whether defendant's product stores in memory individual articles. Compare Jenkins Dep. p. 108 (Exh. B Motion) with operator's manual P.6 attached" J.A. 292. The judge did not identify any trial issue, legal or factual, with respect to the meaning of the patent.

The sole fact issue identified by the trial court concerned the accused system's ability to store article descriptions in memory. Petitioners, to create an apparent fact dispute, had pointed to a statement in the DATAMARK operator's manual that data, including article descriptions, was "saved in DATAMARK memory and printed on the laundry/dry cleaning ticket." While that statement was literally true, the article descriptions are erased from the limited DATAMARK memory once the ticket is printed. Article descriptions are "saved" only for the moment between when they are entered and when the ticket is printed.

Evidence at trial about the capabilities of the accused device was neither sophisticated nor voluminous. In fact, the presentation of all of the evidence took less than two trial days.

Petitioners' first witness was Mr. Mikula, an expert on bar codes who had studied and operated the accused system. He admitted that once the invoice was printed, Westview's system did not store individual article descriptions in memory, and did not track articles of clothing. J.A. 36-38. Thus, there was no dispute about the capabilities of the accused device.⁴

The rest of the trial consisted of Petitioners' efforts to interpret the language of the patent so that the claims would encompass the accused system. Since Westview's system does not identify extra or missing clothing, does not generate any reports about articles and does not maintain an inventory total, Petitioners argued that inventory did not mean clothes. Their expert witness on claim interpretation, Mr. Chovanes, was a patent lawyer who had no skill in the dry cleaning art. Nevertheless, in Petitioners' words, he "interpreted the claims of the patent and testified on how the claims of the patent read on the accused system."⁵ Pet. Br. 5. The lawyer's testi-

4. After this admission, and in the middle of Respondents' cross-examination of Mr. Mikula, the trial judge decided *sua sponte* to bifurcate the trial, planning to try the question of infringement first and issues of validity second. J.A. 42-44. Westview had moved before trial for such a bifurcation and its motion had been denied.

5. Mr. Chovanes' testimony consisted of legal conclusion supported by a fair amount of doubletalk. For example:

mony was that spurious additions or deletions to "inventory" are spurious deletions and additions to invoices. J.A. 73-74. He redefined the "report" that reconciles article descriptions against invoice numbers as an invoice. J.A. 71. He argued that the "tag" attached to the articles is an invoice. J.A. 128-193.

Mr. Chovanes' claim interpretation was contradicted by the documentary record, which established that inventory meant articles of clothing.⁶ The patent documents also demonstrated that the invoice, tags and the report are each separate documents.⁷

Q: Is it your testimony here today that this patent does not require the system to be able to keep track of individual articles of clothing?

A: Well, again, that question has to be answered this way. It does keep on the tickets which are then attached — which are to be attached and are attached to the batches, to the articles as called for in the claims, it does keep track. You can reconcile all the items on that and through the total, and through the invoice number the total and invoice number are back in the "Datamarx," you can reconcile the whole works where, as they say themselves, whereby missing and extra you can find out where they are so you are in that sense if a person comes in and you do all those things and so forth, you are keeping — you are reconciling with the invoice number the articles and with the actual inventory of articles out on line so the claim, what the claim calls for is what I have gone over there in great detail and that's all present, that's the test of infringement. Are the elements of the claim or their equivalent present in the accused structure and we've shown how they are or I have tried to show how they are.

J.A. 97-98.

6. The patent specification makes it certain that "inventory" means articles of clothing, as the following examples reveal:

"[A] basic function of inventory control is the counting of incoming and outgoing materials" J.A. 296, col. 1, ln. 19-20.

"The identity of specific articles must be monitored, making inventory control somewhat more complicated" J.A. 296, col. 1, ln. 21-23.

"[A] problem which appears to occur randomly in the inventory (e.g., damage to garments)" J.A. 298, col. 5, ln. 59.

"[I]ncoming articles to be placed in inventory are accumulated over a counter. . ." J.A. 298, col. 6, ln. 8.

"[I]ndividual article tags may be attached to items in inventory" J.A. 299, col. 8, ln. 9-10.

Additional examples are found in the Federal Circuit's opinion at 37a-38a. See also Petitioner Markman's remarks in support of the amended patent at J.A. 314.

7. For example, the specification distinguishes between tags and reports, stating: "the bar code tags are attached to articles of clothing and

The patentee, Mr. Markman, testified at trial. Petitioners objected to Respondents' cross-examination of Mr. Markman about the meaning of his claim on the basis that Markman was not a "patent expert." J.A. 169. Mr. Markman protested repeatedly that he could not interpret the language because he was not a patent attorney; he knew only how the patent was "implemented at his company" and stated that "I get as messed up in this language as anybody." J.A. 174.

Respondents moved for a directed verdict at the close of Petitioners' case because the question of claim interpretation was determinable as a matter of law, and because there was not even an arguable factual dispute over the accused system. The trial judge deferred ruling on the motion in accordance with Rule 50 of the Federal Rules of Civil Procedure.⁸

Respondents did not call any witnesses to testify about the meaning of the claims because their meaning was readily discernable from the patent specification and prosecution history. Their only witness was Mr. James Jenkins, Westview's president, who explained and then demonstrated how the accused system worked.

On cross-examination, Petitioners elicited testimony about the meaning of "inventory" when used by Mr. Jenkins to describe the capabilities of the accused system. Mr. Jenkins

NOTES (Continued)

are used with the scanning apparatus to facilitate generation of reports according to various management needs." J.A. 293. The patent-in-suit also refers to "bar code records and tags," thereby differentiating tags from invoices. J.A. 293. Additionally, Figure 2 of the specification, J.A. 294, clearly shows a multiple part record that includes an invoice (numbered 46 and referred to in the specification as "an establishment ticket copy" at J.A. 299, col. 7, ln. 44-45) and detachable tags (numbered 48 and referred to in the specification as "article tags" at J.A. 299, col. 7, ln. 46). Finally, the specification states that the optical scanning station is used to reconcile inventory articles. J.A. 300, col. 9, ln. 57-59. Inventory articles can be reconciled at an optical scanning station by reading tags attached to the articles. However, reading just invoices with an optical scanner does not reconcile articles because it does not divulge any article-specific information.

8. The practice of deferring a ruling on a Rule 50 motion is encouraged in the Advisory Committee Notes to that rule. Fed. R. Civ. P. 50 advisory committee note, 1991 Amendment subdivision (b).

testified that a dry cleaner was concerned about two kinds of inventory, both "cash" and "articles of clothing." He explained that the Westview system was designed to look after cash. J.A. 212. Mr. Jenkins was not asked to testify about what the claim language meant to him as one skilled in the art. Rather, Petitioners' counsel obtained the admission from Mr. Jenkins that he had "a very difficult time with language in patents." J.A. 205. After Mr. Jenkins testified, Respondents offered into evidence the prosecution history of the original and reissue patents, rested on infringement, and renewed their Rule 50 motion.

In his summation, counsel for Petitioners reminded the jury that Respondents had presented no expert on claim language and that Respondents' president — one skilled in the art — had not interpreted the claim language because "he has trouble knowing what that means" and the interpretation of claim language is "an area of expertise." J.A. 231. He argued that the jurors should accept the testimony of the patent lawyer, "who has taught law," that the accused system infringes the patent. J.A. 231.

Respondents requested jury instructions construing the claim language for the jury as well as the use of special interrogatories to require the jury to apply the claim interpretation as given by the trial judge. Petitioners objected, claiming that interpretation of the claims was for the jury to decide. J.A. 241. The trial judge's instruction included a mere reading of the claim language to the jury. The trial judge told the jury that "you must determine the meaning of the claims taking the interpretation as I've explained it to you using the relevant patent documents including the specifications, the drawings and the file histories" J.A. 253. Respondents objected to the court's failure to interpret the claim for the jury and the instruction that the jury must determine the claims. J.A. 264.

After deliberation, the jury returned contradictory findings that Respondents had infringed Claim 1 and Claim 10 but not the broader Claim 14. The trial judge then heard argument on and granted Respondents' motion for a directed verdict.

6. The Trial Court's Opinion. In its Opinion and Order granting Respondents' motion for a directed verdict, the trial

court held that claim construction is a matter of law for the court. The district court cited case law holding that "a mere dispute concerning the meaning of a term does not itself create a genuine issue of material fact." 171a. The court concluded that the plaintiffs' expert tried to redefine common words in unusual and novel ways in order to sustain infringement. The judge observed that the expert's "artificial" reading of the claim is that "report" means "invoice"; "attached to said articles" means "attached to a plastic bag that covers a batch of the articles"; and "inventory" means "cash" or "invoices" but not "articles of clothing." 173a. The court determined that these definitions were contrary to the ordinary and customary meaning of the terms and the obvious meaning intended by the patentee as used in the specifications, the drawings and file wrapper. 173a.

The court regarded the patent lawyer's testimony as "unhelpful" because claim meaning is a matter of law for the court. 173a. Interpreting words in the patent as the Petitioners urged would require "semantic antics" because it would require a system that detects and localizes spurious additions and deletions of dollars to inventory and would require defining "inventory" in a dry cleaning system to mean only "cash" and not "articles of clothing." 175a. Since the claim meaning was clear on the face of the patent, and there was no dispute over the capabilities of the accused device, the court directed the verdict in favor of Respondents.

7. Proceedings in the Federal Circuit. Petitioners appealed and the case was fully briefed and argued before a panel of the Federal Circuit. Eighteen months later, the Federal Circuit *sua sponte* issued an order for rehearing of the case *in banc*. In a subsequent order, the Court requested the parties to brief four questions.⁹

After briefing and oral argument, the Federal Circuit issued the opinion that is before the Court today. The court's

9. The Federal Circuit's orders and the text of the four questions are reproduced in the Appendix to the Petitioners' Petition for Writ of Certiorari at 162a-167a.

nearly unanimous judgment was that the district court was correct to grant Respondents' motion for directed verdict.¹⁰

The majority opinion, joined by eight judges, characterized Petitioners' argument as follows:

Markman contends that the jury was properly given the question of claim construction and that the jury's claim construction and verdict thereon is supported by substantial evidence. The evidence Markman points to in support of the jury verdict is not the language of the patent specification or prosecution history, but rather Markman's own testimony as inventor and the testimony of his patent expert. He also relies on the use of the word "inventory" in Westview's product literature and on the testimony of its president. Markman's position essentially is that all the evidence of the meaning of the word "inventory," from the patent, prosecution history, experts, and documents, was properly lumped together and submitted to the jury for it to resolve what in fact is the meaning of "inventory," and that the result of this process is entitled to highly deferential review both by the trial court on motion for JMOL and by this court on appeal from the grant or denial of JMOL.

16a.

The Federal Circuit, rejecting Petitioners' assertions, held that the district judge was correct to construe the patent as a matter of law and that the construction was subject to *de novo* review on appeal. The Federal Circuit agreed with the district court that the testimony of Mr. Chovanes, Petitioners' legal expert, amounted to no more than legal opinion that the trial court was free to accept or reject as it saw fit, stating:

When legal "experts" offer their conflicting views of how the patent should be construed, or where the legal expert's view of how the patent should be construed conflicts with the patent document itself, such conflict does

10. *Markman v. Westview*, 52 F.3d 967 (Fed Cir. 1995) (Archer, C.J., joined by seven other judges); *id.* at 989 (concurrence by Mayer, J.); *id.* at 998; (concurrence by Rader, J.) *id.* at 999; (dissent by Newman, J.).

not create a question of fact nor can the expert opinion bind the court or relieve the court of its obligation to construe the claims according to the tenor of the patent.

42a.

The Federal Circuit ruled that extrinsic evidence cannot be used to change the meaning of the claims. The Court agreed that the trial court properly used the patent documents to interpret the claims and, upon review of the claim language, specification and prosecution history, concluded that the district court's claim construction was correct. 36a-43a.

The Federal Circuit also agreed with the trial court that the Petitioners' proffered claim interpretation was illogical. Thus, the phrase "detect and localize spurious additions to inventory as well as spurious deletions therefrom," logically must refer to clothing and not "dollars" or "invoices." Dollars do not travel through the plant and the location of invoices within the plant is unimportant. Only clothes need to be localized, because they can be lost or stolen at different points as they travel through the plant. Also, "spurious additions" and "spurious deletions" to inventory logically relate to clothing because dollars and invoices would not be spuriously *added* to a dry cleaning inventory. 37a.

In its general holding, the majority resolved a split in Federal Circuit authority as to whether there could ever be jury triable fact issues subsidiary to claim construction. The Federal Circuit stated:

We therefore settle inconsistencies in our precedent and hold that in a case tried to a jury, the court has the power and obligation to construe as a matter of law the meaning of language used in the patent claim.

30a.

Judge Mayer, who is quoted heavily by Petitioners, filed a separate opinion in which he opposed the majority's broad conclusions about the role of juries in infringement cases in which claim construction requires extrinsic evidence. Despite his disagreement with the majority on these matters, he concurred in the judgment on the ground that the trial court's

claim construction was proper because the meaning of the patent did not require inquiry beyond the patent documents. 57a, 61a n.2. Judge Rader filed a separate concurring opinion on the basis that the Federal Circuit should not have decided whether subsidiary fact issues relating to claim interpretation should be determined by the judge or the jury, because there were no such fact issues present in this case. He specifically concluded that there was no substantial evidence to support the jury's findings. 81a-83a.

The sole dissenter, Judge Newman, would have remanded the case to allow the trial judge to apply the "substantial evidence" standard to the jury verdict. 159a. Thus, the concurring judges agreed with the trial court's claim construction, and the single dissent did not argue that this construction was incorrect. The center of the disagreement within the *in banc* panel was the effect of the majority's opinion on future patent cases, not its judgment as to this case.

The Federal Circuit opinion relied on the traditional standard for review of a grant of JMOL: substantial deference is given to factual findings of the jury, but the legal standards applied by the jury in reaching the verdict are considered *de novo* to determine their correctness as a matter of law. 19a. Applying that standard to this case, the Federal Circuit found that the trial court properly construed the claims as a matter of law, stating:

Correctly reasoning that claim construction is a matter of law for the court, the district court properly rejected the jury's verdict and granted JMOL. Upon our *de novo* review of the court's construction of the claim language, we agree that "inventory" in claim 1 includes within its meaning "articles of clothing." It is undisputed that Westview's device does not and cannot track articles of clothing. Accordingly, there is no substantial evidence to support the jury's finding of infringement of claims 1 and 10 of United States Reissue Patent No. 33, 054 when those claims are correctly construed. The district court's grant of judgment of non-infringement as a matter of law is **AFFIRMED**.

56a.

SUMMARY OF ARGUMENT

Petitioners assert that the decision of the Federal Circuit in this case violates the Seventh Amendment's guarantee of a right to a jury trial. This argument depends on several assumptions. Petitioners must posit that there was a real factual dispute in the case, that the trial court improperly usurped the jury's role by directing a verdict in favor of the Respondents, and that the judgment of the Federal Circuit affirming the trial court, thus, is flawed. But none of the necessary predicates to Petitioners' arguments is present in this case.

Petitioners' brief is fixed on fact disputes over scientific evidence, but there was no scientific or technical evidence given at trial. Petitioners refer to expert disputes, but there were no such disputes because Respondents had no expert at trial and because Petitioners' supposed expert was simply a patent lawyer who had no training in the relevant art and put forth no "evidence." This was not a case where the trial judge determined credibility of disputing witnesses over issues of what someone skilled in the dry cleaning art would understand the patent claims to mean. Testimony like that presented at trial, giving only distorted legal conclusions in contradiction of the written record, is not competent evidence at all. It was the trial judge's obligation to decide matters of law in the case, as in all cases, and that obligation extended to construction of the plain meaning of the patent claims at issue.

In this case the Federal Circuit overwhelmingly agreed that the documentary record revealed the one susceptible meaning of the claim, and that extrinsic evidence was not a necessary part of proper claim construction. Claim construction clearly was a matter exclusively for the judge, and his judgment as a matter of law was appropriate.¹¹

11. The judgment in Respondents' favor is correct whether claim interpretation is always purely a matter of law or whether it may sometimes involve fact-findings on genuinely disputed terms. Since there was no real dispute in this case, the distinction here is immaterial. Alternatively, assuming *arguendo* that there were genuine issues in dispute, which Respondents deny, the judgment was still appropriate because the trial record easily reveals that there was no substantial evidence to support the jury verdict. The judgment can be affirmed under either of these analyses.

The Seventh Amendment question addressed by Petitioners relates to the Federal Circuit majority opinion's statements concerning the respective roles of judge and jury in interpreting claim language when testimony of those skilled in the art might be necessary to reveal the technical meaning of the claim to the trial court. While these statements may extend beyond this case, the Federal Circuit's view that claim construction in those circumstances is a question of law for the court is consistent with the precedent of this Court.

The properly framed constitutional question here is how the Seventh Amendment affects the determination of whether a particular issue in a jury trial, in this case, claim construction, is a matter of law for the judge or a matter of fact for the jury. This Court repeatedly has held that it is the essence of the common law jury's fact-finding role that is preserved, not the incidents and details. The allocation of roles between judge and jury is necessarily flexible because of the indistinct and sometimes shifting line between law and fact. Judge and jury roles also have changed as federal procedures and modern substantive laws have evolved.

The determination of how the task of claim construction should be allocated between judge and jury at trial today therefore must take into account both the roles of judge and jury in pre-1791 infringement cases and the evolution of those roles through history as trial practices and the patent system have developed. The Seventh Amendment framework supports the majority's conclusion that judges, not juries, construe patent claim language as a matter of law. Under this analysis, the essence of the jury's historical role in infringement trials is undisturbed, just as the sound policies toward providing uniformity and consistency in patent law are advanced.

The Federal Circuit properly rejected Petitioners' contention that claim interpretation becomes an issue of fact whenever extrinsic evidence is used as an aid to determine the meaning of patent claims. While a judge who is not skilled in the art may need testimony from an expert to explain the meaning of technical terms, this does not change the legal nature of claim construction. This process parallels other areas

of the law, where judges often consider extrinsic evidence to interpret written documents and determine foreign law.

The patent system's policies are advanced by the Federal Circuit's broader holding in this case. Patents are private monopolies of public rights. Patent claims are statutorily required to define the invention clearly and specifically so that the public can know the boundaries of the patent while it is in effect and benefit from its teaching after the patent expires. Their meaning cannot properly turn on determinations of witness credibility or demeanor.

Consequently, genuine fact disputes concerning the meaning of claim language to those skilled in the art cannot arise because the patent statute does not permit ambiguity. If the patent is truly ambiguous, it is simply invalid. Construction of claims as a matter of law both guards against unlawful ambiguity and promotes needed certainty in the patent system.

ARGUMENT

A. The Trial Judge Properly Construed The Petitioners' Patent Claims As A Matter Of Law.

Petitioners try to raise a Seventh Amendment claim by contending that there were fact issues underlying the construction of the claim language involved. They ignore the trial record and the claim construction actually undertaken by the trial judge and do not discuss the opinion of the Federal Circuit as it relates to the record below. When Petitioners' Seventh Amendment arguments are viewed in the context of the trial record, one sees immediately how extreme and inherently flawed these arguments are.

At trial, Petitioners' own witness testimony revealed that there was no dispute about the capabilities of the accused device. To avoid an inevitable legal conclusion to the case based on the meaning of the patent claims, Petitioners focused their efforts on attempting to redefine dispositive claim terms in contradiction to the written record. The key words were "inventory," "attached to," "report" and "invoice" — terms

easily understood by lay people and artisans alike. Rather than putting forth the testimony of someone skilled in the art, Petitioners relied on a patent lawyer who testified over Respondents' objection about the legal meaning of the patent claims.¹² This individual had no skill or expertise in the subjects taught in the patent. Expert instead in the lawyerly craft of linguistic legerdemain, he twisted the words of the claim so that they meant what Petitioners wanted them to mean.

As parsed against this record, Petitioners' legal arguments run as follows: the Seventh Amendment preserves the right to jury trial; juries find facts; the interpretation of claim language is completely factual whenever the parties' lawyers argue over the meaning of any claim word, no matter how simple the term, and no matter how artificial the argument; the judge can make no rulings of law on the meaning of claim terms once such a dispute is concocted and at trial must allow all testimony on the meaning of claim terms, even if the testimony contradicts the written record, and no matter how unfamiliar the witness is with the art in question; the judge must let the jury consider this testimony, whatever its content, and must thrust the claim language, the prosecution history, the specification and the drawings at the jury and instruct them to "figure it out"; and the jury is free to disregard the written record in favor of the aforementioned testimony. Obviously, the Seventh Amendment right to a jury trial cannot support all of Petitioners' far-flung assertions.

A quick examination of the well-settled principles of claim interpretation reveals the flaws in Petitioners' arguments. In an infringement case, the determining issue is whether the patent claims, properly construed, read on the

12. Petitioners have done an interesting about-face in strategy. At trial, their strategy was to impugn the claim interpretation abilities of the two witnesses who knew anything about the pertinent art, presumably to bolster the testimony submitted by their patent lawyer. Petitioners thus objected to cross-examination of the inventor (who testified that he did not understand the claim) about the claim language, and even attacked Respondents' president about his trouble understanding claim language. Now, however, they trumpet the testimony of these witnesses on the general meaning of the term "inventory," even though the testimony was not elicited in context of the term as used in the patent documents.

accused device. *Coupe v. Royer*, 155 U.S. 565, 579 (1895). While the capabilities of the accused device and the ultimate issue of infringement are jury issues, claim language is a matter of law for the judge. *Id.*

The judicial process for interpreting claims is well-known. The first step is to look at the claim itself. *Read Corp. v. Portec*, 970 F.2d 816, 821 (Fed. Cir. 1992). If necessary, the court also should consider the full documentary record, which includes the specification and prosecution history. *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrochrome*, 796 F.2d 443, 480 (Fed. Cir. 1986), *cert. denied*, 404 U.S. 823 (1987). Where the documentary record is clear, the determination of terms in the claim is for the court. This conclusion is compelled by a legion of cases. See, e.g., *Exhibit Supply Co. v. Ace Patents Corp.*, 315 U.S. 126, 134 (1942); *Smith v. Snow*, 294 U.S. 1, 14 (1935); *Singer Mfg. Co. v. Cramer*, 192 U.S. 265, 275 (1904); *Market St. Cable Ry. Co. v. Rowley*, 155 U.S. 621, 625 (1895); *Coupe v. Royer*, 155 U.S. 565, 579 (1895); *Looms v. Higgins*, 105 U.S. 580, 596-99 (1882); *Heald v. Rice*, 104 U.S. 737, 749 (1882); *Keystone Bridge Co. v. Phoenix Iron Co.*, 95 U.S. 274, 276 (1877); *Turrill v. Michigan So. & Northern Indiana R.R. Co.*, 68 U.S. 491, 509-11 (1864); *Winans v. New York and Erie R.R. Co.*, 62 U.S. (21 How.) 88, 100 (1859); *Winans v. Denmead*, 56 U.S. (15 How.) 330, 339 (1854); *Silsby v. Foote*, 55 U.S. (14 How.) 218, 225-26 (1853); *Hogg v. Emerson*, 47 U.S. (6 How.) 437, 484 (1848), citing *Earle v. Sawyer*, 4 Mass. 1 (C.C.D. Mass. 1825).¹³

Although in some circumstances expert testimony may be necessary to explain terms of art to the judge, such testimony cannot contradict the clear meaning of the documentary

13. This view is shared by the Federal Circuit and other federal courts of appeal. See, e.g., *SSIH Equip., S.A. v. United States Int'l Trade Comm'n*, 718 F.2d 365, 376 (Fed. Cir. 1983); *Devex Corp. v. General Motors Corp.*, 667 F.2d 347, 357 (3d Cir. 1981), *aff'd*, 461 U.S. 648 (1983); *Del Francia v. St-Anthony Corp.*, 278 F.2d 745, 747 (9th Cir. 1960); *Solomon v. Renstrom*, 150 F.2d 805, 807-08 (8th Cir. 1945); *Cold Metal Process Co. v. E.W. Bliss Co.*, 285 F.2d 231, 239 (6th Cir. 1960), *cert. denied*, 366 U.S. 911 (1961); *Automatic Pencil Sharpener Co. v. Boston Pencil Pointer Co.*, 279 F. 40, 41-44 (1st Cir. 1922), *cert. denied*, 260 U.S. 728 (1922); *Brothers v. Lidge-wood Mfg. Co.*, 223 F. 359, 364 (2d Cir. 1915).

record. *Intellicall, Inc. v. Phonometrics, Inc.*, 952 F.2d 1384, 1388 (Fed. Cir. 1992); *Kohn v. Eimer*, 265 F. 900, 902 (2d Cir. 1920) (Hand, J.). Moreover, no expert can presume to answer the legal question for the judge of what the ultimate meaning of the claim language is. See *Nutrition 21 v. United States*, 930 F.2d 867, 871 n.2 (Fed. Cir. 1991). The recognition that such testimony is not competent evidence is long-standing. This Court has noted that a judge cannot be compelled to receive expert testimony on terms in a specification because "[e]xperience has shown that opposite opinions of persons professing to be experts may be obtained to any amount. . . ." *Winans v. New York and Erie R.R. Co.*, 62 U.S. at 100-101. Similarly, Judge Learned Hand observed that such testimony in contradiction to the written record "is inevitably a burdensome impertinence." *Kohn*, 265 F. at 902.¹⁴

By these standards, the testimony of Petitioners' patent "expert" was not evidence at all but the assertion of legal conclusions. In short, he was trying to supplant the trial judge. Since his legal conclusion contradicted the documentary record, the trial court was obligated to disregard it, and did so. 173a. Moreover, the testimony by the inventor and Respondents' president added nothing because it was not even couched in the context of the terms as used in the claims. Petitioners' witness "evidence" was the equivalent of testimony that a color is green when the documents say the color is purple.

The fact that the trial court allowed the expert legal testimony to go to the jury did not transform claim construction from a judge issue to a jury issue. The jury's contradictory answers on infringement made the judge's duty to construe the claims all the more apparent. When the trial judge then performed the requisite claim construction, he ruled that the meanings of the key terms in the claim were clear from the documentary record. The trial court rejected Petitioners' urged interpretation of these terms as "artificial" and "con-

14. Judge Hand observed in another case that "[a]rgument is argument whether in the box or at the bar, and its proper place is the last." *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 123 (2d Cir. 1930), *cert. denied*, 282 U.S. 902 (1931).

trary to their ordinary and customary meaning, as well as the obvious meaning intended by the patentee." 176a. Since no dispute existed about the capabilities of the accused device, the trial court granted Respondent's motion for directed verdict.

The trial court's ruling in this case was upheld by ten of eleven judges on the Federal Circuit on the basis that no fact disputes were presented at trial.¹⁵ The Federal Circuit's rejection of Petitioners' attempt to manufacture a factual dispute is unremarkable and follows the well-established precedent of this Court.

B. The Seventh Amendment Does Not Prohibit A Judge From Interpreting Patent Claims As A Matter Of Law.

Petitioners argue that the Seventh Amendment right to jury trial is implicated in this case because neither the Federal Circuit nor the trial judge applied the substantial evidence standard to the jury's "construction" of the claim language. This argument is premised on the mistaken assertion that juries interpreted claims at common law, and that all matters of fact for common law juries must be determined by juries today.

Petitioners' arguments run counter to the weight of authority. The Seventh Amendment preserves the role of both judge and jury at common law. It does so in jury trials by preserving the essential nature of those roles, not their incidents and procedural details. In the context of jury triable issues, the

¹⁵ Petitioners curiously quote from Judge Mayer's concurrence. He found that this case involved only issues of interpretation of the written record — the claim, the specifications and prosecution history — and therefore that the trial court correctly resolved the meaning of the claim language as a matter of law. 61a n.2 (no excursion needed beyond the patent documents). See also Judge Rader's concurrence at 81a ("The testimony of Markman's patent law expert is not evidence at all") (citing *Nutrition 21 v. United States*, 930 F.2d 867, 871 n.2 (Fed. Cir. 1991)). Even Judge Newman, the lone dissenter, has stated this principle in another case; see *Advanced Cardiovascular Sys. v. Scimed Sys.*, 887 F.2d 1070, 1076 (Fed. Cir. 1989) (Newman, J., dissenting) (expert testimony cannot change the meaning of ordinary terms, as understood in light of the specification, prosecution history, and prior art).

division between judge and jury has never been fixed to a rigid historical analysis, other than through the general notion that the Seventh Amendment preserves the role of judge as law-determiner and jury as fact-finder. The historical inquiry is so limited because the line between judge and jury in jury trials at common law fluctuated and was indistinct. Moreover, in this country both the roles of judge and jury and the procedures governing them at trial have evolved over time making any strict historical analysis both impossible and against sound policies.

Historical analysis, thus, provides limited guidance in examining the particular question of whether the judge or the jury interprets patent claims. Indeed, the present patent claim system was not mandated until 1870. The jury's role in English common law patent cases was markedly different from the jury's role in American patent cases today. Nevertheless, a close reading of patent cases both at English common law and in this country confirms that the court, not the jury, interpreted claim and specification language. Despite the limitations of the historical record, it supports the Federal Circuit's analysis in this case — the construction of patent claims is properly given to the court.

1. Cases Dealing With The Distinction Between Law And Equity Are Not Helpful In Distinguishing Between Issues Of Law And Issues Of Fact.

The Seventh Amendment reads simply that "In suits at common law, where the value in controversy shall exceed twenty dollars, the right of trial by jury shall be preserved, and no fact tried by a jury, shall otherwise be reexamined in any Court of the United States, than according to the rules of common law." The history of the passage of the Amendment indicates that it was not intended to freeze the roles of juries in jury-triable cases, but rather to prevent the wholesale abolition of juries in the new country.

The right to jury trial was well-known in English common law and was practiced in all of the states at the time of the Constitutional Convention. See Charles W. Wolfram, *The Constitutional History of the Seventh Amendment*, 57 Minn. L.

Rev. 639, 653-54 (1973); Kenneth S. Klein, *The Myth of How to Interpret the Seventh Amendment Right to a Civil Jury Trial*, 53 Ohio St. L. J. 1005, 1008, 1010 (1992). The Framers, as well as the individual states, were intent on preserving some right to civil jury trials in this country's government. Klein, *supra*, at 1008-10; Edith G. Henderson, *The Background of the Seventh Amendment*, 80 Harv. L. Rev. 289, 299 (1966). The commitment grew out of the fear of the capricious power of the judge of chancery that was part of the English system, as well as out of anti-federalist sentiments. Wolfram, *supra*, at 742-43. As this Court explained in *Colgrove v. Battin*, 413 U.S. 149, 152 (1973), the controversy generating the Amendment was not animated by "concern for preservation of jury characteristics at common law, but by fear that the civil jury itself would be abolished unless protected in express words."

There was very little attention given to discussion of this proposition at the Constitutional Convention. As many commentators have pointed out, there is scant written record indicating any significant debate or even discussion of the right to jury trial. Henderson, *supra*, at 291; Klein, *supra*, at 1008; Wolfram, *supra*, at 657. It is likely that the Framers felt that any significant pronouncement on civil juries in the Constitution would become mired in protracted disputes because the practice of jury trials among the states was so diverse. Klein, *supra*, at 1014; Wolfram, *supra*, at 665-66.¹⁶

During ratification several states expressed strong interest in preserving some form of right to jury trial in civil cases. The First Congress responded by proposing a constitutional amendment on the subject. But because of the lack of uniformity on the nature of jury rights among the states, the job of crafting meaningful amendment language was undoubtedly perplexing. James Madison, the chief author of the final product, apparently cobbled together an amalgam of language proposed by various states during the ratification process. Klein,

16. One framer noted that any such general clause would have been "pregnant with embarrassments." Klein, *supra*, at 1014. General Washington later noted that civil rights were omitted from the Constitution for fear of intruding on established state practices. *Id.* at 1014-15 (citation omitted).

supra, at 1018. Again, there was astonishingly little debate in the First Congress over the drafting of the amendment. *Id.* The final result was a guarantee framed in general terms that protected the jury trial right without trampling the states' practices. *Id.* at 1016-20. Yet by avoiding particulars, the language does little to explicate the precise scope of the right.

Aside from expressing a general desire to preserve the institution of the jury, the Framers gave no particularized consideration to the roles of judge and jury in a case where the right is preserved. The Reexamination Clause reflects the Framers' general belief that appellate courts should be prevented from abrogating the civil jury's fact-finding role by finding new facts on appeal, but the Framers also knew that jury facts could be reviewed in some manner at common law. See Henry Slocum, *New Trials and the Seventh Amendment*, 8 U. Ill. L. Rev. 292, 300-01 (1913). Again, however, specifics were not addressed. As Edith Henderson pointed out in her exhaustive review of the drafting and ratification of the Seventh Amendment:

Nowhere in the history of the Philadelphia convention, the ratifying conventions of the several states, or the specific 'legislative history' of the Bill of Rights can any evidence be found that the relation of judge to jury was considered as affected in any but the most general possible way by the seventh amendment, or even that it was considered at all.

Henderson, *supra*, at 290.

This historical background is important because it illuminates the two quite distinct inquiries that can arise under the Seventh Amendment. The difference between the two is of particular relevance here because Petitioners have confused the more common inquiry, whether the jury trial right attaches to a particular cause of action, with the less common inquiry involved here of whether a particular issue in a jury trial is for the court or for the jury.

Twenty years after the Seventh Amendment's passage, Justice Story gave the interpretation of the Seventh Amendment that set the standard for future jurisprudence on the issue. In *United States v. Wonson*, 28 F. Cas. 745 (C.C.D. Mass.

1812), the Justice found that the common law alluded to in the Seventh Amendment "is not the common law of any individual state (for it probably differs in all), but it is the common law of England, the great reservoir of all our jurisprudence." *Id.* at 750. Labelling this conclusion "obvious," Justice Story gave no citations for his assertion, but the federal courts have adopted his comments as the benchmark of Seventh Amendment analysis. Wolfram, *supra*, at 641. As the courts have interpreted Justice Story's statement, there is an implicit requirement that Seventh Amendment analysis start from the vantage point of jury trial practice at common law at the date of adoption of the Amendment in 1791. *See, e.g., Ross v. Bernhard*, 396 U.S. 531, 534 (1970); *Dimick v. Schiedt*, 293 U.S. 474, 476 (1935).¹⁷

This framework supports two different inquiries, depending on the type of jury issue involved. The most common question is whether the Constitution provides a right to jury trial in a particular action. This issue arises as Congress creates new statutory rights and remedies that must be analyzed to see whether they are analogous to remedies tried to juries at the common law. Fleming James, Jr., *Right To A Jury Trial in Civil Actions*, 72 Yale L. J. 655, 656 (1963). This inquiry usually turns on whether the matter in question is more analogous to matters heard in law courts or to matters heard in equity courts. Much of the jurisprudence from this Court on the Seventh Amendment has focused on this inquiry. *See, e.g., Granfinanciera, S.A. v. Nordberg*, 492 U.S. 33, 41-42 (1989); *Tull v. United States*, 481 U.S. 412, 426 (1987); *Pernell v. Southall Realty*, 416 U.S. 363, 370-71 (1974); *Fleitman v. Welsbach St. Lighting Co. of Am.*, 240 U.S. 27, 29 (1916).

Petitioners apply this "law/equity" distinction to this case, even though the question of whether a jury trial can be demanded in a particular action has no relevance here. Respondents do not dispute that a jury right under the Seventh Amendment attaches to patent infringement actions for

17. This conclusion has not escaped criticism. In a recent article, for example, commentator Klein argues that this historical mode of analysis may be less faithful to the purposes behind the Seventh Amendment than a functional analysis. Klein, *supra*, at 1034-36.

damages, since there is no doubt that in 1791 litigants brought these cases at common law. Here, the question before the Court turns on how the Seventh Amendment affects the roles of judge and jury in cases where a jury right exists. This is a separate inquiry. *See In re Peterson*, 253 U.S. 300, 310 (1920) ("No one is entitled in a civil case to trial by jury, unless and except so far as there are issues of fact to be determined").

2. The Case Law Concerning The Roles Of Judge And Jury In A Jury Trial Teaches That The Seventh Amendment Preserves The Essence Of The Jury Right, Not Matters Of Form And Procedure.

The courts have less frequently addressed the question of how the Seventh Amendment affects the roles of judge and jury in the course of a jury trial than they have the more fundamental question of whether there is any right to a jury trial. In contrast to the rather fixed historical analysis of the law/equity inquiry,¹⁸ the focus of this second inquiry is less easily defined. Without question, the "right of jury trial in civil cases at common law is . . . basic and fundamental," *Jacob v. City of New York*, 315 U.S. 752, 752 (1942), so that any seeming curtailment of this right "should be scrutinized with the utmost care." *Dimick v. Schiedt*, 293 U.S. 474, 486 (1935). Furthermore, the Amendment gives constitutional dimensions to the well-known English common law maxim that "issues of law are to be founded by the court and issues of fact are to be determined by the jury under appropriate instructions by the court." *Baltimore & Carolina Line v. Redman*, 295 U.S. 654, 657 (1935), citing *Walker v. New Mexico R.R. Co.*, 165 U.S. 593, 596 (1897).

However, it is equally clear that the Seventh Amendment preserves only the basic institution of the jury trial, and not its details. Time and again this Court has stated that the substance of the right is preserved, not matters of particular form

18. On which many courts have commented may "reek unduly of the study," if not, by Justice Clark's view, of the museum. *See* Martin H. Redish, *Seventh Amendment Right to Jury Trial: A Study in the Irrationality of Rational Decision Making*, 70 Nw. U. L. Rev. 486, 487 (1975), citing *Damsky v. Zavatt*, 289 F.2d 46, 48, 59 (2d Cir. 1961).

and procedure. See, e.g., *In re Peterson*, 253 U.S. 300, 309 (1920); *Walker*, 165 U.S. at 596; *Galloway v. United States*, 319 U.S. 372, 392 (1943). "The procedure of the first half of the seventeenth century or of the second half of the eighteenth century surely was not 'fastened upon the American jurisprudence like a strait-jacket, only to be unlocked by Constitutional amendment.'" Austin W. Scott, *Trial by Jury and the Reform of Civil Procedure*, 21 Harv. L. Rev. 669, 670 (1918), quoting *Twining v. New Jersey*, 211 U.S. 78, 101 (1908) (discussing due process of law).

Thus, numerous attacks have been made against the power of judges to take cases from juries, on the basis that the Seventh Amendment permits only procedures known at the common law. This approach has been consistently rejected since the mid-nineteenth century. See *Galloway*, 319 U.S. at 389 n.19 (1943) (collecting cases). This rejection is based on two factors: in the common law system itself, the jury's role was constantly in flux; and courts routinely exercised authority that effectively took away from the power of juries to decide facts. Both points were explicated succinctly in *Galloway*:

[T]he argument from history is not convincing. It is not that 'the rules of the common law' in 1791 deprived trial courts of power to withdraw cases from the jury, because not made out, or appellate courts of power to review such determinations. The jury was not absolute master of fact in 1791. Then as now courts excluded evidence for irrelevancy and relevant proof for other reasons. . . . The Amendment did not bind the federal courts to the exact procedural incidents or details of jury trial according to the common law in 1791, any more than it tied them to the common-law system of pleading or the specific rules of evidence then prevailing. Nor were 'the rules of the common law' then prevalent, including those relating to the procedure by which the judge regulated the jury's role on questions of fact, crystallized in a fixed and immutable

system. On the contrary, they were constantly changing and developing during the late eighteenth and early nineteenth centuries.

Id. at 389-391 (citations omitted).

As the Second Circuit put it in *Dagnello v. Long Island R.R. Co.*, 289 F.2d 797, 804 (2d Cir. 1961), the single purpose of the Amendment is to preserve the essentials of jury trial and to safeguard the jury's function from encroachment that the common law did not permit. This does not, and cannot, mean that the roles of judge and jury at common law, if they even can be clearly deciphered, are to be adhered to in every detail for all times. There are obvious limitations to the strict comparison of jury practices in pre-1791 English common law with jury practice today, since "asking how 1791 England would deal with a 1991 multi-district patent infringement case is a little like asking how the War of the Roses would have turned out if both sides had airplanes." Klein, *supra*, at 1028.

For example, early in the law juries were required to have personal knowledge of the incidents at issue, and parties were disqualified from testifying because of self-interest. Patrick Devlin, *Jury Trial of Complex Cases: English Practice at the Time of the Seventh Amendment*, 80 Colum. L. Rev. 43, 80 (1980); James B. Thayer, "Law and Fact" in *Jury Trials*, 4 Harv. L. Rev. 170-74 (1890); James, *supra*, at 662. As that practice eroded, a system of superjurors arose, in which the same men in a particular parish, educated and qualified freeholders all, sat on civil cases involving their particular trade or profession. Devlin, *supra*, at 80-83. Inevitably, judge and jury knew each other well, and rendering a verdict in a case was at times a sort of informal group reasoning session. *Id.* Legal historians have noted that Lord Mansfield developed the law of modern commercial litigation by using a group of sea merchant jurors who informed him on how legal standards should

be set according to the practices of the trade. *Id.* at 81-82.¹⁹ The lines between law and fact, and judge and jury, were slippery indeed. They varied from time to time, issue to issue, and court to court.

At common law, English judges could take a case away from a jury and decide it as a matter of law. By 1791, an English judge could take cases from a jury on matters of law by, variously, granting a new trial, a nonsuit or a demurrer to the evidence. Henderson, *supra*, at 299-302. In addition, the phrase "to direct a verdict" was known and often used. *Id.* at 302. These procedures had the effect of reserving for later judicial decision questions of law arising during trials, and of taking verdicts subject to the ultimate resolution of the legal issue. *Baltimore & Carolina Line*, 295 U.S. at 659; *Galloway*, 319 U.S. at 390-391.

These procedures followed by 18th century common law courts are the precursors to the modern federal procedures of summary judgment and judgments taken as a matter of law. There has been no constitutional impediment to adoption in the Federal Rules of Civil Procedure of devices that limit the role of the jury in hearing evidence. The Seventh Amendment

does not prohibit the introduction of new methods for determining what facts are actually in issue, nor does it prohibit the introduction of new rules of evidence New devices may be used to adapt the ancient institution to present needs and to make of it an efficient instrument in the administration of justice.

In re Peterson, 253 U.S. at 309-10; see also *Baltimore & Carolina Line*, 295 U.S. at 657.

Here, the trial judge's use of the directed verdict device in determining the meaning of the claims as a matter of law was directly in line with the power of judges under the common law. The directed verdict device is a common feature of

19. "In 1761, for example, [Lord Mansfield] let a jury decide what would now be regarded as a pure question of law; namely, whether a shipper, whose cargo of sugar had been damaged on the voyage, could recover under his insurance policy . . . the profit he would have made on an imminent rise in the market." Devlin, *supra*, at 83. See also James B. Thayer, "Law and Fact" in *Jury Trials*, 4 Harv. L. Rev. 171, 173 (1890).

American jurisprudence and has been used countless times to resolve cases without violating either clause of the Seventh Amendment. This Court made this clear in *Capital Traction Co. v. Hof*, 174 U.S. 1, 13-14 (1899):

[A]t the common law and in the American constitutions, [trial by jury] . . . is a trial by a jury of 12 men in the presence and under the superintendence of a judge empowered to instruct them on the law and to advise them on the facts, and (except on acquittal of a criminal charge) to set aside their verdict, if, in his opinion, it is against the law or the evidence.

The Seventh Amendment preserves not only the jury's role, but also the judge's role as the governor of the trial. *Herron v. Southern Pacific Co.*, 283 U.S. 91, 95 (1931) (discharge of the judicial function as at common law is an essential factor in the due process which the Federal Constitution provides). When in the performance of that role the judge ascertains that an issue cannot be subject to any material dispute, it is the judge's obligation to decide the issue as a matter of law.

3. To The Extent That The Historical Record Is Pertinent, It Supports The Proposition That Judges, Not Juries, Construe Claim Language.

Even though an inquiry into the historic practices of the common law is of limited value, it nonetheless demonstrates that the construction of patent claims is an issue for the judge, not jury. To examine the effect of the Seventh Amendment on patent infringement trials, one first must compare the system of patent claiming and patent trials at the English common law to the modern claiming system and modern infringement trials. No historian can make a comparison of an institution through time without understanding its function in the context of the system in which it works, and how that system — and by necessity the jury role in it — has changed. The patent definition system currently practiced in the United States differs significantly from the systems practiced in 1791 England or in the early years of this country. There is no precise corre-

late in the historic record to modern patent infringement actions because the system of patent claiming has changed in style and content.

The theoretical price extracted from the inventor for the grant of the patent monopoly was (and is) that the patentee teach the public the invention for use after the life of the monopoly. This concept was a fundamental part of patent trials at the early English common law. See, e.g., XI W. S. Holdsworth, *History of English Law* 427 (1938). It was paramount that the inventor give the "recipe" for the patent in the specifications. Likewise, the requirement of a claim did not appear in this country until the Act of 1836, and a typical claim at that time was only a catalog of certain elements without explanation of what they meant and how they were to operate. The claim often simply referred to the specifications and was subordinate to the fuller description in those documents. R. Ellis, *Patent Claims* §6 (1949). The court in an infringement trial was left with the task of sorting out what was a material element of an invention, which not surprisingly required resort to the patented device. *Id.* Distinct claims were not required until 1870, when Congress provided by statute that the applicant "shall particularly point out and distinctly claim the part, improvement, or combination, which he claims as his own invention." Act of 1870, ch. 230, Sec. 26, 16 Stat. 198 (July 8, 1870).

Given the historic predominance of the specification, patent claiming first operated on the central claiming theory, in which claims were not required to be rigorously defined and so named the features of the invention by reference to its specification. *Ex parte Fressola*, 1993 Pat. App. LEXIS 3, *4 (Bd. Pat. App. & Interferences 1993). Under this system "the drawings and descriptions were the main thing, the claims merely an adjunct." A. Deller, *Patent Claims* § 4 (2d ed. 1971), cited in *Ex parte Fressola*, 1993 Pat. App. LEXIS at *4. In this century, however, the patent process has evolved into a peripheral claiming system, where the claim is statutorily required to be set out strictly and in practice sets forth the boundary of the area marked by the claim. *Id.*; see also John A. Diener, *Claims of Patents*, 18 J. Pat. Off. Soc. 389, 391-93

(1936) (explaining the peripheral claiming system's growth out of the American culture of individualism). The modern peripheral claim system is thus quite different from its predecessor in its focus on the specificity of the claim language, which must describe the "metes and bounds" of the patent monopoly. 35 U.S.C. §112 now requires that the specification be written in "full, clear, concise, and exact terms" and that it include claims "particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention."

Thus, cases involving claim construction under the old central definition system focused on whether the patented invention was the technical equivalent of the accused device. As the peripheral claim system developed, the focus changed, and the law of infringement came to center on whether the claims, which now predominated, read on the accused device. The effect of this change was to give the claims of the patent a new prominence, but at the same time to give the claims a more specific, abstract quality as the legal boundaries of the invention, rather than a specific "recipe" for making it.

The historical record must be considered in this context. Judges at English common law, just as judges today, were charged with the general duty of interpreting written documents as a matter of law. Patrick Devlin, *Jury Trial of Complex Cases: English Practice at the Time of the Seventh Amendment*, 80 Colum. L. Rev. 43, 75-76 (1980). This is not surprising. At the time of the passage of the Seventh Amendment, English juries were often illiterate. *Id.* at 75; see also Stephen Weiner, *The Civil Jury Trial and the Law-Fact Distinction*, 54 Cal. L. Rev. 1867, 1932 (1966).

The Petitioners' conclusions about English common law cases are uniformly misleading. The historical record does not show that juries interpreted patents in England in 1791. A close reading of each of the cases cited by Petitioners demonstrates that juries were performing two basic tasks: they determined whether specifications adequately "taught" a person skilled in the art how to reconstruct the invention, and they determined whether the devices at issue were the same inven-

tion. The first task, the modern equivalent of an enablement defense, was particularly important because of the significance of the specification in the patent system. Juries determined whether the patented inventions at issue could be copied by skilled craftsmen, and often heard testimony from craftsmen who tried to make the device from the specifications. I J. Oldham, *The Mansfield Manuscripts and the Growth of English Law in the Eighteenth Century* 732 (1992).

Thus, in *Liardet v. Johnson*, (K.B. 1778), a defendant asserted that a patent was invalid because its specification had not adequately described how to make the invention. Lord Mansfield asked the jury to determine the enablement function of the specifications, not the meaning of the words themselves.²⁰ Accordingly, Petitioners' reliance on this case for the proposition that claim interpretation was a matter for the jury reflects a basic misunderstanding of the case.

Similarly, at issue in *Turner v. Winter*, 1 T.R. 602 (K.B. 1787) was whether the specification was adequate to teach the public how to make the invention. *Id.* at 605. The jury in that case heard testimony from witnesses who literally followed the "recipe" of the instructions in the specification to see whether the substances produced were what were detailed in the specification. *Id.* "Therefore, if the process, as directed by the specification, does not produce that which the patent professes

20. Petitioners' citation to the "influential 1791 authority," Francis Buller, erroneously implies that Buller stated that juries must determine the meanings of specifications. Pet. Br. 25. The authority cited, *Trials Nisi Prius*, says nothing about juries. Buller summarized the *Liardet* case by stating, "The general questions on patents are, 1st, whether the invention were known and in use before the patent. 2d, whether the specification is sufficient to enable others to make it up. The meaning of the specification is, that others may be taught to do the thing for which the patent is granted" F. Buller, *An Introduction to the Law Relative to Trials at Nisi Prius* ch. VII (6th ed. 1791). It is furthermore clear that Lord Mansfield believed that judges, and not juries, determine the meaning of written documents. In *Macbeath v. Haldimand*, 1 T.R. 172, 99 Eng. Rep. 1036 (K.B. 1786) he and Justice Buller agreed with a lower court's order that directed a verdict for the defendant, because "there was no evidence which was proper for [the jury's] consideration for the evidence consisting altogether of written documents and letters which were not denied, the import of them was matter of law and not of fact." 1 T. R. at 180, 99 Eng. Rep. at 1040.

to do, the patent itself is void." *Id.* The jury was not given the words of the specification and told to decipher their meaning.

Petitioners' reliance on *Neilson v. Harford*, 8 M. & W. 806 (Exch. Pleas 1841) is curious, since it directly supports the Federal Circuit's opinion. The judge in *Neilson* made it clear that he construed the specification language at trial, since specifications, like all written documents, are to be construed as a matter of law. *Id.* at 822. As in *Liardet* and *Turner*, the jury's role was limited to ascertaining whether the instructions in the specification could produce the claimed invention and arose from a defendant's claim that the patent specification was insufficiently specific. *Id.* The jury's duty at trial was to ascertain whether a competent workman could follow the instructions in the patent. *Id.* at 824. Likewise, two other cases cited by Petitioners, *Arkwright v. Nightingale*, Davies Pat. Cas. 38 (Common Pleas 1785) and *Hornblower v. Boulton*, 8 T. R. 95 (K. B. 1799), are also enablement cases. *Arkwright*, Davies Pat. Cas. at 50-53 (five witnesses testified that they could make the machine from specifications); *Hornblower*, 8 T.R. at 99 (whether patentee gave adequate directions in specification was question for the jury).

At other times, the jury was called upon to compare the patented device with the accused device, to see if the patented device were "new." This is the inquiry undertaken by the juries in *Bovill v. Moore*, Davies Pat. Cas. 320 (Common Pleas 1816) and *Huddart v. Grinshaw*, Davies Pat. Cas. 200 (K.B. 1803). The juries did not "interpret" the involved specifications but rather looked at the inventions to determine if they had been disclosed by prior art.²¹

21. Petitioners' summary of *Collins v. Sawrey*, 4 Bro. P.C. 692 (H.L. 1772) is also misstated. In *Collins* the question was whether the claims at issue sought equitable rights and remedies or legal ones. It was held that the case involved legal issues and so should not be heard by the Court of Exchequer, but rather at law — i.e., by a "single judge, by a jury at an assize . . ." *Id.* at 699. Petitioners' omission of the phrase "before a single judge" and connection of the phrase "written evidence" to "by a jury" make it seem as if the question of whether the jury, as opposed to the judge, should construe written evidence. This was not at issue in the case. Likewise, in *Mayor of Kingston Upon Hull v. Horner*, 1 Cowp. 102 (K.B. 1774), the holding was not, as Petitioners tell it, that the interpretation of a charter is a question of

Later sources confirm that English common law courts construed patent language as a question of law, even where extrinsic evidence was required to understand the claim. As 1 Thomas Brett, *Commentaries on the Present Laws of England*, (1890) puts it, "The construction of a specification is the province of the Court, but evidence will be heard in explanation of technical terms used in the arts, or phrases used in particular trades. The rules of construction applicable to specifications are those applied to the interpretation of written instruments." *Id.* at 289. See also *Brooks v. Steele*, 14 R.P.C. 73 (1896) where the Court said,

The judge may, and indeed generally must, be assisted by expert evidence to explain technical terms, to show the practical working of machinery described or drawn, and to point out what is old and what is new in the specification But after all, the nature of the invention for which a patent is granted must be ascertained from the specification, and has to be determined by the judge and not by a jury, nor by any expert or other witness. This is familiar law, although apparently often disregarded when witnesses are being examined.

Id.; see also *Harrison v. Anderson Foundry Co.*, 1 App. Cas. 581 (1874) (interpretation of specifications is for the court).

C. The Consideration Of Extrinsic Evidence Does Not Change An Issue Of Law To An Issue Of Fact.

1. This Court Has Consistently Held That Claim Construction Is A Matter Of Law Even Where Extrinsic Evidence Is Used As An Aid To Construction.

NOTES (Continued)

fact for the jury. The holding was that the jury properly determined upon strongest possible evidence that a port was an ancient port because it had been enjoyed for 350 years. The meaning of a term in the charter was not at issue; the length of use of the port was. *Id.* at 108. In any event, even if the Petitioners' interpretation of these cases were correct, they would prove too much: construction of deeds and charters is now a clear matter of law for the court. See, e.g., *Driggins v. Okla. City*, 954 F.2d 1511, 1513 (10th Cir. 1991), cert. denied, 113 S. Ct. 129 (1992).

This Court has held repeatedly that claim construction is a matter of law. In infringement cases, this means that the judge defines the patent and the jury decides whether the accused device is covered by the patent claim. In one early decision, *Winans v. Denmead*, 56 U.S. (15 How.) 330 (1854), the Court explained it this way:

On . . . trial for [infringement] two questions arise. The first is, what is the thing patented; the second, has the thing been constructed, used, or sold by the defendants. The first is a question of law, to be determined by the court, construing the letters-patent, and the description of the invention and specification of claim annexed to them. The second is a question of fact, to be submitted to the jury.

Id. at 338. Likewise, in *Coupe v. Royer*, 155 U.S. 565 (1895), this Court said:

The doctrine of the cases is aptly expressed by Robinson in his work on Patents, vol. 3, page 378, as follows: "Where the defence denies that the invention used by the defendant is identical with that included in the plaintiff's patent, the court defines the patented invention as indicated by the language of the claims; the jury judge whether the invention so defined covers the art or article employed by the defendant."

Id. at 579. In practice, then, the judge construes the words of the patent claim, while the jury makes fact-findings about the capabilities of the accused device. Thus, the *Winans* court construed the letters patent by determining structure, mode of operation, and the result obtained from a patent. *Winans*, 56 U.S. at 338. In *Silsby v. Foote*, 55 U.S. (14 How.) 218 (1853), construction of the combination patent claim was reserved to the court, while the jury was assigned the role of determining what parts of the machine were necessary to effect a particular result. *Id.* at 225-26. In *Coupe v. Royer*, 155 U.S. 565 (1895), the court's job was to give proper instructions to the jury on the scope of the patent, and the jury had to decide the question of infringement. *Id.* at 579.

This Court has repeatedly noted that it is the judge's duty to examine the written record in determining claim construction as a legal matter. The trial court's and the Federal Circuit's decisions in this case, that the claim language, specification and prosecution history show clearly that "inventory" includes "articles of clothing," stand squarely in line with this Court's precedent. Every case cited by Petitioners as contradictory to the Federal Circuit's decision is actually firmly in support of this basic principle. See *Singer Mfg. Co. v. Cramer*, 192 U.S. 265, 275 (1904) (face of the instruments allows the judge, by comparing their terms, to determine the inventions described in the patents); *Market St. Cable Ry. Co. v. Rowley*, 155 U.S. 621, 625 (1895) (in an anticipation case, issue of whether prior patents were for the same invention as the patent at issue was matter of law; court could decide the issue by comparing the patents); *Heald v. Rice*, 104 U.S. 737, 749 (1882) (Court interpreted the issue of whether a reissue patent was for the same invention as the original patent and found it a matter of law for the court where no extrinsic evidence was necessary); *Keystone Bridge Co. v. Phoenix Iron Co.*, 95 U.S. 274, 276 (1877) (Court held that the claim language clearly did not cover the defendant's invention, so no verdict of infringement).

Not surprisingly, Petitioners fail to recognize the consistency of the Federal Circuit's holding with precedent and center their contentions on the question of extrinsic evidence. In doing so, they move well beyond the record in this case. Here again, however, Petitioners' citation to Supreme Court case law is misleading. Although this Court has never directly considered the question, there is ample support in the precedent for the conclusion that the use of extrinsic evidence does not change the character of claim construction as one of a pure legal issue for the judge.

Rather than supporting a Seventh Amendment right to jury trial when extrinsic evidence is necessary to explain terms of art in a patent, this Court's decisions have indicated that it is the role of the court to avail itself of such information if necessary as an aid to performing its legal duty of construing the claim. In *Looms v. Higgins*, 105 U.S. 580 (1882), the Court

availed itself on appeal of the testimony supplied by weaving industry experts in construing the meaning of a looming patent in an infringement case. *Id.* at 586. Similarly, the Court relied on the testimony of experts at trial in *Winans v. Denmead*, 56 U.S. (15 How.) 330 (1854) to understand the mode of operation of the patent in suit. *Id.* at 341. And in *Hogg v. Emerson*, 47 U.S. (6 How.) 437 (1848) the Court found the specification to be clear by its terms, citing *Earle v. Sawyer*, 4 Mason 1 (C.C.D. Mass. 1825), where the Court ruled on the clearness of the description of the specification, with such explanatory testimony as the experts and machinists furnished. *Id.* at 484-85.

Winans v. New York and Erie R.R. Co., 62 U.S. (21 How.) 88 (1859) is particularly instructive. There, the patent at issue was for an improvement in the construction of railroad cars. The patentee sued for infringement, and the defendant raised an invalidity defense based on numerous claims of prior art. This Court held,

There was in fact but one question to be decided by the court, viz: the construction of the patent; the question of novelty being the fact to be passed on by the jury. The testimony of experts which was rejected had no relevancy to the facts on which the jury were to pass, but seemed rather to be intended to instruct the court on some mechanical facts or principles on which the court needed no instruction, or to teach them what was the true construction of the patent. Experts may be examined to explain terms of art, and the state of the art, at any given time. They may explain to the court and jury the machines, models, or drawings, exhibited . . . [P]rofessors or mechanics cannot be received to prove to the court or jury what is the proper or legal construction of any instrument of writing. A judge may obtain information from them, if he desire it, on matters which he does not clearly comprehend, but cannot be compelled to receive their opinions as matter of evidence. . . . If the construction given by the court to the specification be correct, and in fact the only construction of which it is capable, as we think it is, it would be wholly superfluous

to examine experts to teach the court, what they could clearly perceive without such information

Id. at 100-01.²²

Petitioners try in vain to find cases that conflict with this Court's precedent that claim construction is a matter of law. First, the cases cited by Petitioners refer to the use of extrinsic evidence in dictum only. In every case on which Petitioners rely, the Court determined the patent meaning on the record before it. *See Singer Mfg. Co.*, 192 U.S. at 275; *Market St. Cable Ry. Co.*, 155 U.S. at 625; *Heald*, 104 U.S. at 737. Moreover, the allusion to the use of extrinsic evidence in these cases is not germane to the current system of claiming. Rather, the consideration of "extrinsic evidence" involved a determination of what the invention did — much as the jury today in an infringement case determines the capabilities of the accused device. In *Singer*, for example, the Court made a determination of whether a claim defined solely by its specification was the technical equivalent of the accused device. 192 U.S. at 275. In *Market St. Cable Ry. Co.* and *Bischoff*, the question was whether the prior patent disclosed the same invention as the current patent. 155 U.S. at 625; 76 U.S. at 816. In *Heald*, the question was whether the reissue patent was for the same invention as the previous patent. 104 U.S. at 737. And in *Tucker v. Spalding*, 80 U.S. 453 (1871), the question was whether an identity existed between the accused device and the patented device. *Id.* at 454.

The argument that the decision below is in conflict with this Court's precedent is thus misconceived. Supreme Court authority holds that claim construction is a matter of law for the court, regardless of whether extrinsic evidence is necessary to inform the court of the meaning of the claim language.

22. *See also* Albert Walker, *Textbook of the Patent Law of the United States of America* (3d ed. 1895), where the influential American patent expert states that judges are free to avail themselves or reject expert testimony on the meaning of particular phrases on the way to construing patents as matters of law. *Id.* at 173-74.

2. The Use Of Extrinsic Evidence In The Interpretation Of Documents Other Than Patents Does Not Transform The Issue From One Of Law To One Of Fact.

In other areas, the consideration of extrinsic evidence does not change an issue of law into an issue of fact for the jury. *United States v. Weitzenhoff*, 1 F.3d 1523, 1531-32 (9th Cir. 1993) (fact that judge allowed jury to hear expert testimony about meaning of EPA permit did not change construction of permit from question of law to question of fact). Courts routinely consider extrinsic evidence, including testimony, as an aid in other cases where they are called upon to interpret the meaning of documents as a matter of law. In this fashion, courts construe statutes, foreign laws, consent orders and treaties. *See Order of Ry. Conductors v. Swan*, 329 U.S. 520, 525 (1947) (documentary evidence and testimony considered as an aid to construing a statute); *Overseas Dev. Disc Corp. v. Sangamo Constr. Co.*, 840 F.2d 1319, 1324-26 (7th Cir. 1988) (expert testimony considered in determining foreign law); *cf. United States v. Reader's Digest Ass'n*, 662 F.2d 955, 961 (3d Cir. 1981), *cert. denied*, 455 U.S. 908 (1982) (underlying administration complaint examined as an aid in construction of consent order); *Choctaw Nation of Indians v. United States*, 318 U.S. 423, 431-432 (1943) (when construing a treaty, courts may consider extrinsic evidence concerning the history of the treaty, the negotiations, and the practical construction adopted by the parties).

Judges also routinely make rulings on "facts" in ways that prevent matters from going to a jury, without running afoul of the constraints of the Seventh Amendment. Judges make evidentiary rulings in determining relevance, competence of witnesses, probity, and prejudice, and they even review trial proceedings in ruling on questions of issue preclusion. These are all matters of law for the judge, although they may have factual underpinnings, and though the judge's ruling may profoundly affect the scope of the jury's factfinding authority.

There has been much discussion about the best analogy to patent interpretation. This decision is not critical to the issue before the Court. Ultimately, the quest for an analogy cannot provide an answer to the question before the Court, and there

is no precise analog to claim interpretation. But a closer look at how trial judges deal with other written instruments is helpful to understanding the judge's role in construing claim language.

The interpretation of a statute is similar to the interpretation of a patent claim. A patent and a statute both are delineations of public rights and/or obligations. They are each applicable to all persons similarly situated. The construction of a patent or statute establishes a standard that will then impact on people who were not involved in the drafting of the document. Although the construction of a statute begins with its words, where necessary, the court can consider extrinsic evidence or testimony, like legislative history or committee reports. See *Order of Ry. Conductors v. Swan*, 329 U.S. 520, 525 (1947). The consideration of such evidence does not change statutory construction from a legal question to a factual question. See, e.g., *Dakota Nat'l Bank & Trust Co. v. First Nat'l Bank Trust Co.*, 554 F.2d 345 (8th Cir. 1977), *cert. denied*, 434 U.S. 877 (1977). This is equally true of claim construction.

Petitioners argue that claim construction is analogous to contract interpretation, presumably because juries are sometimes called upon to consider parol evidence where it is necessary to determine the meaning of ambiguous words in the contract. This argument is of limited aid because there are significant differences between patents and contracts. Unlike statutes and patents, contracts normally have little or no impact on the public. There is no statutory requirement that a contract be clear and unambiguous and contracting parties are free to write contracts in a language that only they can understand. Since subjective intent is important in a contract interpretation, in an appropriate case, both sides to the contract can testify about the meaning of a contract as a factual matter. In a patent case, there is no subjective intent to determine.

However, in many cases, the meaning of contract language is interpreted as a matter of law without the need for extrinsic evidence. Moreover, even where contract language is disputed, a court can and should accept expert testimony to help it to determine whether or not a particular term is

ambiguous. See, e.g., *Mellon Bank, N.A. v. Aetna Business Credit*, 619 F.2d 1001, 1011 (3d Cir. 1980). This does not change the character of the determination of whether ambiguity exists from law to fact.

D. The Federal Circuit's Decision Advances Patent Law Policies.

1. The Construction Of Patent Claims As A Matter Of Law Promotes Specific And Clear Claims And Consistent Interpretation.

Contrary to Petitioners' suggestions, the jury retains its key role in patent cases. While patent validity is ultimately a matter of law, juries decide underlying fact issues involving obviousness, anticipation, and prior use or sale. *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966); *Atlas Powder Co. v. E. I. DuPont de Nemours & Co.*, 750 F.2d 1569, 1573 (Fed. Cir. 1984); *U.S. Envtl. Prods., Inc. v. Westall*, 911 F.2d 713, 715 (Fed. Cir. 1990). In infringement trials, juries decide as fact issues the capabilities of the accused device, file wrapper estoppel, the doctrine of equivalents claim and, of course, the issue of damages. See, e.g., *Hilton Davis Chem. Co. v. Warner-Jenkinson Co.*, 62 F.3d 1512, 1524 (Fed. Cir. 1995). In fulfilling these tasks, the jury is called upon to perform its traditional function of finding facts.

At the same time, the Federal Circuit's reaffirmation that claim construction is a matter of law serves important policy goals. Congress created the Federal Circuit for the express purpose of promoting uniformity, predictability, and fairness in patent law. H.R. No. 97-312, 97th Cong., 1st Sess. at 9 (1981). The aims are achieved in the policies underlying the Federal Circuit's decision in this case. The Federal Circuit has reached a compelling conclusion: patents are fully integrated written instruments that should be interpreted uniformly as a matter of law. As the Federal Circuit noted, the exclusive grant of right to the patentee makes it only fair that competitors "be able to ascertain to a reasonable degree the scope of the patentee's right to exclude." 28a, citing *Merrill v. Yeomans*, 94 U.S. 568, 573-74 (1877). The only way a patent claim can

receive universal treatment is for it to be construed as a matter of law. If not, the same patent language could be subject to different interpretations by different juries in different infringement actions. There would be no uniformity, and definitely no certainty.²³ Most claims can be readily interpreted upon a judge's review of the documentary record.²⁴ After all, the patentee is statutorily required to set forth both the claim and specification with clarity and specificity. 35 U.S.C. §112. A litigation-induced parade of experts cannot change the meaning of the claim or the nature of the inquiry. Even a claim term that raises some complexity for the judge, who is not skilled in the art, does not change the issue from law to fact. The judge may need assistance from experts skilled in the art to understand what the term means, but if the patentee has complied with Section 112, there should be no dispute in the relevant community.

23. Petitioners argue that determination of patent claims as a matter of law promotes uncertainty until the appellate process is complete. Yet the supposed uncertainty created by the appellate process in this situation is no different from that involved in the interpretation of the words of any statute or regulation. The general uniformity fostered by interpreting these documents as matters of law is greater than any temporary uncertainty created by the appellate process. The temporary uncertainty created by the appellate process is far less than the permanent uncertainty created by allowing different juries to find different meaning in the same patent.

24. Petitioners cite to two district court opinions expressing concerns over the timing of a judge's claim construction. In one of these cases, *Lucas Aerospace, Ltd. v. Unison Indus., L.P.*, 890 F. Supp. 329, 332 n.3 (D. Del. 1995), the Federal Circuit opinion in this case was issued days after the court had allowed claim construction to go to the jury in an eleven-day trial. Despite the opinions of these two judges, an overwhelming majority of district court judges have applied with no difficulties the directives of the Federal Circuit in this case, even upon consideration of extrinsic evidence. See, e.g., *Rolite, Inc. v. Wheelabrator Technologies, Inc.*, 1995 U.S. Dist. LEXIS 16453 at *4 (E.D. Pa. 1995) (construing claims on motion for partial summary judgment); *Edward Lowe Indus., Inc. v. Oil-DRI Corp. of Am.*, 1995 U.S. Dist. LEXIS 15790 at *5 (N.D. Ill. 1995) (same); *American Perma-hedge, Inc. v. Barcana, Inc.*, 1995 U.S. Dist. LEXIS 15838 at *10-11 (S.D.N.Y. 1995) (same); *Century Wrecker Corp. v. E.R. Buske Mfg. Co., Inc.*, 898 F. Supp. 1334, 1343-46 (N.D. Iowa 1995) (on motion in limine, ruling that court must instruct jury on interpretation to be given claim language).

Nor does the truly ambiguous patent term present a fact question. If two persons skilled in the art reasonably could interpret the same claim language differently, there is no need for further inquiry, because the patent has failed to satisfy its statutory obligation. Under Section 112, the patentee is required to distinctly and precisely state his or her claim, and if the patentee fails, the patent is invalid. This Court has emphasized the importance of and reasons for clarity and specificity in claim language:

Patents . . . must comply accurately and precisely with the statutory requirement as to claims of invention or discovery. The limits of a patent must be known for the protection of the patentee, the encouragement of the inventive genius of others, and the assurance that the subject of the patent will be dedicated ultimately to the public. The statute seeks to guard against unreasonable advantages to the patentee and disadvantages to others arising from uncertainty as to their rights.

General Elec. Co. v. Wabash Appliance Corp., 304 U.S. 364, 369 (1938) (citations omitted).

This then is not just a theoretical issue. Patents are normally drafted by lawyers, not artisans. Often the lawyer's goal is to draft the patent claims with some ambiguity to allow the patentee to expand or constrict the patent as subsequent events dictate.²⁵ This has led to the anomalous situation that occurred in this case, where only the drafting lawyers, and not those skilled in the art to whom the patents are directed, can understand the claim language. Putting teeth into the requirements of Section 112 so that patents are drafted to teach rather than to spawn litigation, will undoubtedly result in more precise patent claiming, and fewer patent infringement cases.

25. See, e.g., Arthur H. Seidel, et al., *What the General Practitioner Should Know About Patent Law and Practice* 65 (5th ed. 1993):

The greatest possible effort should be exerted to avoid adopting a position in which the applicant may later be placed in a corner. It is much better technique, when possible, not to pinpoint the essence of patentability to a particular feature and, instead, to attempt to leave a certain amount of ambiguity or room to maneuver should very pertinent prior art be subsequently unearthed.

2. Adoption Of Petitioners' Argument Would Result In Serious Limitations On Procedures And The Evolution Of Law.

The line between "fact" and "law" is often nebulous, and judges undoubtedly have different thresholds for determining what is a genuine dispute of fact.²⁶ This Court has said that "no rule or principle [exists] that will unerringly distinguish a factual finding from a legal conclusion" *Pullman-Standard v. Swint*, 456 U.S. 273, 288 (1982). Where the distinction is difficult to make, it may turn on a policy analysis of who, in the administration of justice, is in a better position to decide the question. *Miller v. Fenton*, 474 U.S. 104, 113-14 (1985).

The Seventh Amendment does not require that the characterization of what is law and what is fact remain forever frozen, even if it were possible to distinguish law from fact in every case. Such a rigid outlook would prevent numerous developments in the law, such as this Court's refinement in *Daubert v. Merrill Dow/Pharmaceuticals*, 113 S. Ct. 2786 (1993), of the judge's role as the gatekeeper of expert testimony. It would also unduly constrain efforts to modernize the Federal Rules of Civil Procedure. For example, in 1966 Rule 44.1 of the Federal Rules of Civil Procedure was adopted. The Rule requires that determinations of foreign law be made as matters of law. A judge determining foreign law issues is free to look at any relevant source, including expert testimony. *Overseas Dev. Disc Corp. v. Sangamo Constr. Co.*, 840 F.2d 1319, 1324 (7th Cir. 1988), citing *United States v. Peterson*, 812 F.2d 486, 490 (9th Cir. 1987). Although now clearly questions of law, historically, issues of foreign law were at times viewed as factual. See, e.g., *Liverpool & G.W. Steam Co. v. Phoenix Ins. Co.*, 129 U.S. 397, 442 (1889). The ruling Petitioners request in this case would place the constitutionality of this Rule in doubt.

26. For example, this Court has noted that Rule 52(a) provides no particular guidance on distinguishing law from fact, just as it has recognized the sometimes critical importance of drawing the line between these two concepts. *Bose Corp. v. Consumers Union of United States, Inc.*, 466 U.S. 485, 501 (1984).

Any holding under the Seventh Amendment that patent construction is for the jury may put potentially serious limits on Congressional powers. Doubts would arise whether Congress could adopt other procedural devices that designate matters for the court. Such a holding also could handicap Congress's power to further reform patent law, for example by further refining the 35 U.S.C. § 112 requirements for patent drafting. Such a result would indeed "strait-jacket" the constantly evolving nature of federal procedure and jurisprudence.

If the jury must interpret every patent claim regardless of whether a dispute about claim language is reasonable, then a true sea change will be effected in patent law. The number of infringement cases decided by juries will surge, since it is child's play to create a dispute about the meaning of words. Cases in which imaginative but unreasonable interpretations previously would have been rejected as a matter of law will have to be decided by the jury. Trial judges will rarely be able to grant summary judgment on infringement issues because both prongs of the infringement analysis will turn on matters of fact. The time-honored balance between law and fact in patent infringement cases will be skewed. Trials will be lengthier and more complicated because each side will have to hire one or more experts to testify about the meaning of the claims. Cases like this one, in which the presentation of all of the evidence took less than two days, will disappear like the dinosaur.

CONCLUSION

Despite the consideration by Petitioners given to the Seventh Amendment, the Court need not reach the constitutional issue to affirm the judgment below. The Seventh Amendment issue was raised by Petitioners in their appeal to the Federal Circuit, and the Federal Circuit addressed the issue to resolve inconsistencies in its precedent and to explain its view for future cases in which disputes may be raised over technical terms. The Federal Circuit's teaching is compelled by precedent and sound policy. Yet, the fundamental issue here is whether the trial court correctly interpreted the claim language in this case as a matter of law. The Federal Circuit held that he did. The judgment of the Federal Circuit can be upheld on this basis alone.

For the foregoing reasons, Respondents respectfully request that this Court affirm the judgment of the United States Court of Appeals for the Federal Circuit affirming the trial court's grant of Respondents' motion for a directed verdict.

Respectfully submitted,

Frank H. Griffin, III

Counsel of Record

Peter A. Vogt

Polly M. Shaffer

GOLLATZ, GRIFFIN & EWING, P.C.

Two Penn Center Plaza

16th Floor

Philadelphia, PA 19102

Attorneys for Respondents

WESTVIEW INSTRUMENTS, INC. and

ALTHON ENTERPRISES, INC.

Dated: December 8, 1995

APPENDIX

35 U.S.C. §112

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

A claim may be written in independent or, if the nature of the case admits, in dependent or multiple dependent form.

Subject to the following paragraph, a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.

A claim in multiple dependent form shall contain a reference, in the alternative only, to more than one claim previously set forth and then specify a further limitation of the subject matter claimed. A multiple dependent claim shall not serve as a basis for any other multiple dependent claim. A multiple dependent claim shall be construed to incorporate by reference all the limitations of the particular claim in relation to which it is being considered.

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.